

REMARKS

This Amendment is submitted in response to the Office Action dated May 9 , 2005 . In the Office Action, the Patent Office rejected Claims 1 -5 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* (U.S. Patent No.: 3,589,155) in view of *Song* (U.S. Patent No .: 5,617,751) and *Callahan* (U.S. Patent No.: 4,235,459). Further, the Patent Office rejected Claims 9-19 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* and *Song* in view of *Miller* (U.S. Patent No.: 6,244,763). Finally, the Patent Office rejected C laims 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* in view of *Song* and *Callahan*, and further in view of *Miller*.

The Patent Office rejected Claims 1 -5 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* in view of *Song* and *Callahan*. The Patent Office alleges that *Kamp* teaches a key tag, as shown in Figures 1-9, that is comprised of a single piece plastic tag or retainer portion, defined as part #2, with a first side and a second side, said first and second sides being configure d to accommodate a label, defined as Part #18, and an opening, defined as Part #3, that is located between said first and second sides for accommodating a key ring. The Patent Office alleges that *Kamp*, as set forth above, discloses all of the features claimed except for the use of metal key tag with one or more integrally formed

openings for accommodating a key ring, and a pre -formatted label card with a plurality of removable labels.

The Patent Office alleges that *Song* discloses a key tag, as shown in Figures 5a-6b, that includes a retainer portion, defined as Part #60, that is made of either plastic or metal, and has an opening, defined as Part #62 in Figures 6a -b, that is integrally formed with said retainer portion between a first side and a second side of said retainer portion for accommodating a key ring, defined as part #10, as described in lines 51-53 of column 4.

The Patent Office states that *Callahan* discloses a marking system, as shown in Figures 1-4 that is comprised of a pre-formed label sheet or card, with a plurality of labels provided thereon, said labels being provided as a system for marking objects such as keys, where said labels are affixed to an object by means of an adhesive. The use of a key tag with a plurality of openings for attaching a plurality of key rings to said key tag would be considered by one of ordinary skill in the art to be an obvious multiplication of parts for the purpose of providing attachment means for a plurality of key rings instead of a single key ring.

Moreover, the Patent Office alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention, to utilize a metal key tag with one or more integrally formed opening for accommodating a key ring, as taught by *Song*, and a pre -formatted label card with a plurality of adhesive labels

thereon, as taught by *Callahan*, in combination with the key tag and labels as disclose by *Kamp* for the purpose of providing a medium for distributing a plurality of adhesive labels for use as markers on key tags.

Kamp illustrates a key holder that has a key ring formed from a length of resilient wire stock and bent to provide a loop and a pair of leg portions. A discoidal retainer or body formed of plastic, has a means for mounting a flat, indicia bearing element on opposite sides of the retainer. The key holder also has a means for detachably engaging the key ring leg portions within the retainer between opposed indicia bearing members and shield components for preventing contact between the leg portions and the indicia bearing members.

Kamp discloses a key ring member 1 that is formed from a length of resilient wire stock bent to define a loop or partiannular section 3 for receiving keys. The key ring member 1 has a pair of legs 4, 4', each of which, at their end are flared slightly outward. The pair of legs 4, 4' are positioned within compartments 14, 16 of the key holder. However, the pair of legs 4, 4' are constructed to be detachable from the key tag body and wherein the ends of the pair of legs are received internally within the body. Therefore, the opening is not integrally formed into the key ring member as required by the present invention.

Song illustrates a key fob including at least one dome with a display surface and a flange secured in a fob. The fob is sewn in a pattern around or through the flange or openings therethrough. The fob may also be formed by placing display domes within an outer rim and sealing the combination within a U-shaped ring. Designs and slogans may be placed on the display surfaces. The fob may then be attached to a key ring using a clip configured to accommodate crimping. The clip attachment allows the fob to rotate freely around the key ring.

Song further specifies that:

"According to another embodiment, the key fob has two thin display inserts placed between two transparent display domes, all of which are seated in a rim. The thin display inserts may be easily replaced and may exhibit pictures, novelty marks, advertising slogans, or the like through the transparent display domes. The pieces are secured together within the rim by a U-shaped ring which fits over the rim assembly. The pieces may be prevented from rotating within the rim by including a notch in each of the pieces and corresponding dimples on the rim. Fabrication is thus simplified while allowing an easily customized

fob, which may be customized by the individual user."

Of significant importance in the *Song* patent, is the essence of fabrication that includes a plurality of pieces that can be customized and interchanged. The display inserts (2) may be inserted under transparent domes and ultimately connected to the-U shaped ring which fits over the rim assembly. However, to be customized and interchangeable, it becomes necessary to have a plurality of parts as required by the *Song* patent, and not a single piece unit as required by the present invention.

Callahan discloses a marking system wherein distinctive, adhesive backed separable markers are carried on a substrate, and printed on the substrate are images of the respective markers with a blank line being printed adjacent each image on which objects marked may be recorded. The system is particularly, though not exclusively, suited to the marking of keys.

Amended Claim 1 requires an apparatus for labeling key tags. The apparatus has a key tag having a first side and a second side where the first side and the second side accommodate a label. Further, the key tag requires at least one opening positioned between the first side and the second side wherein the opening is integrally formed on the key tag. Moreover, the key tag has an opening that accommodates a key ring. Amended Claim 1 further requires that the opening, first side and the second side of the

key tag are a single piece unit. The apparatus also has a pre-formatted label card wherein the label card has a plurality of labels contained thereon wherein the labels may be affixed to either of the first side or the second side of the tag.

However, none of *Kamp*, *Song* and/or *Callahan*, taken singly or in combination teach or suggest a key tag having at least one opening positioned between the first side and the second side wherein the opening is integrally formed on the key tag and further wherein the opening accommodates a key ring as required by Claim 1 of the present invention. Additionally, none of *Kamp*, *Song* and/or *Callahan*, taken singly or in combination teach or suggest a key ring having an opening and a first side and a second side of said key tag that are a single piece unit as required by Claim 1.

More specifically, *Kamp* does not teach or suggest a key tag having an opening integrally formed thereon that accommodates a key ring as required by the present invention. On the contrary, *Kamp* requires that the open be formed by resilient wire stock that may be detachably engageable from the body of the key tag. *Kamp* discloses a pair of legs, each of which are received internally within the body of the key tag. The pair of legs are secured within the body and may be detachable and/or removed from the cavity provided by the retainer/body of the key tag. Additionally, *Song* does not teach or suggest a key tag having a first side and a

second side wherein said key tag is a single piece unit. On the contrary, *Song* teaches a plurality of pieces that are connected together to create a key fob wherein the object of the patent is to fabricate easily customized fobs, which may be customized by the individual user. Moreover, *Song* requires a fob that has one thin display insert displayed through a transparent display dome. The display insert is sandwiched between the display dome and an opaque dome. Essential to the *Song* patent is the interchangeability and customization of the different pieces of the fob for individual use. Nowhere in *Song* is it disclosed the use of a single two sided key tag being a single piece unit.

Further, the Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to modify *Kamp* in view of *Song* and *Callahan* to create Applicant's invention. Since the Patent Office failed to establish a *prima facie* case of obviousness, the rejection of Claims 1 -5 and 7 under 35 U.S.C. §103(a) has been overcome. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform

their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 1-5, and 7 over *Kamp* in view of *Song* and *Callahan* under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the Patent Office rejection of Claims 9 -19 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* in view of *Song* and *Miller*, Applicant respectfully submits that the rejection has been overcome by the amendment to the independent Claim 9 and for the reasons that follow.

Amended Claim 9 requires a key tag labeling system having a key tag having a first opening integrally positioned thereon to accommodate a key ring and a surface to accommodate a label wherein the key tag has a first opening and a surface to accommodate a label that are a single edifice. Moreover, Claim 9 requires a label

having a first side and a second side wherein the first side is adhesively secured to the key label and further wherein the second side of the label is printable thereon. Further Claim 9 requires a downloadable program for label preparation.

Amended Claim 15 requires a method for labeling a key tag, the method comprising the steps of: providing a key tag having a first side and a second side and an opening that is positioned between the first side and the second side for accommodating a key ring wherein the opening is integrally formed in association with the first side and the second side of the key tag as a single piece unit; providing a label to identify the key; providing an indentation on at least one of the first side and the second side of the key tag for receiving the label wherein said first side and said second side of the key tag are fabricated in a single piece construction; and providing downloadable software to support printing of information on the label.

Kamp illustrates a key holder that has a key ring formed from a length of resilient wire stock and bent to provide a loop and a pair of leg portions. A discoidal retainer or body formed of plastic, has a means for mounting a flat, indicia bearing element on opposite sides of the retainer. The key holder also has a means for detachably engaging the key ring leg portions within the retainer between opposed indicia bearing members and shield

components for preventing contact between the leg portions and the indicia bearing members.

Kamp discloses a key ring member 1 that is formed from a length of resilient wire stock bent to define a loop or partiannular section 3 for receiving keys. The key ring member 1 has a pair of legs 4, 4', each of which, at their end are flared slightly outward. The pair of legs 4, 4' are positioned within compartments 14, 16 of the key holder. However, the pair of legs 4, 4' are constructed to be detachable from the key tag body and wherein the end of the pair of legs are received internally within the body. Therefore, the opening is not integrally formed into the key ring member as required by Claim s 9 and 15 of the present invention.

Further, *Song* illustrates a key fob including at least one dome with a display surface and a flange secured in a fob. The fob is sewn in a pattern around or through the flange or openings therethrough. The fob may also be formed by placing display domes within an outer rim and sealing the combination within a u-shaped ring. The fob may then be attached to a key ring using a clip configured to accommodate crimping. The clip attachment allows the fob to rotate freely around the key ring. As previously illustrated, *Song's* key fob alleges that "fabrication is simplified to these interlocking domes that are placed about a U-shaped ring

which allows for interchangeability and customization of the key fob.

Miller teaches a sheet having at least one self adhesive special purpose label arrangement set having a postage indicia label, and addressee label and a sender label, wherein the maximum printable area of the sheet is made available for the labels, and a process for printing these special purpose label arrangement sets. In the process, a computer system with a printer is used to prepare and print the label relating to the address, the sender and the mail piece to be mailed.

Miller does not teach or suggest a labeling system for application to a key tag. On the contrary, the *Miller* patent specifically discloses a label system for mail pieces and accessories. Moreover, *Song* does not teach or suggest a key tag labeling system having a key tag having a first opening integrally positioned on the key tag to accommodate a key ring and a surface to accommodate a label wherein the key tag has a first opening integrally positioned on the key tag and a surface to accommodate a label that are a single edifice as required by Claims 9 and 15.

Additionally, *Kamp* does not teach or suggest a key tag having an integrally positioned opening on the key tag as required by Claims 9 and 15. On the contrary, the opening described by the *Kamp* patent is formed by a removably attached bent wire ring having a

pair of legs that are internally secured to the body of the key tag.

Further, the Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to combine the teachings of *Kamp* and *Song* with the unrelated art of *Miller* to create Applicant's invention. Since the Patent Office failed to establish a *prima facie* case of obviousness, the rejection of Claims 9-19 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect

Planning Corp. v. Feil , 774 F.2d 1132, 1143, 227 USPQ 543, 551
(Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 9-19 over *Song* in view of *Miller* under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

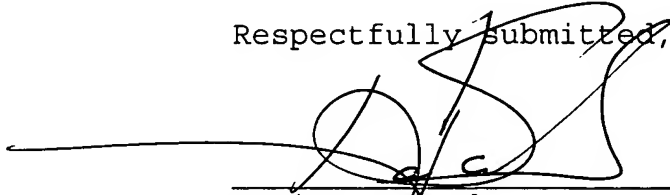
With respect to the rejection of Claims 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over *Kamp* in view of *Song* and *Callahan* and in further view of *Miller*, Applicant respectfully submits that the rejection has been overcome by the amendment to Claim 1, from which Claim 6 and Claim 8 depend. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; Claims 10-14 depend from Claim 9; and Claims 16-19 depend from Claim 15. These claims are further believed allowable over *Kamp*, *Song*, *Callahan* and *Miller*, taken singly or in combination, for the same reasons set forth with respect to independent Claims 1, 9 and 15 since each sets forth additional novel components and steps of Applicant's key tag and system.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and

the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Hani Z. Sayed', is written over a horizontal line. The signature is stylized with large loops and a long horizontal stroke extending to the left.

(Reg. No. 52,544)

Hani Z. Sayed
Gordon & Rees LLP
101 W. Broadway Suite 1600
San Diego, CA 92101
(619) 696-6700 (office)
(619) 230-7474 (direct)
hsayed@gordonrees.com
ATTORNEY FOR APPLICANT



CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service as Express Mail in an envelope addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 19, 2005.

Mimi Beuchat
Mimi Beuchat